

REMARKS

This Amendment is submitted in response to the Office Action dated October 6, 2004, having a shortened statutory period set to expire January 6, 2005. Claims 1, 3, 13, 15, 25, and 27 have been amended and claims 2, 14, and 26 have been cancelled.

Claim Rejections Under 35 U.S.C. § 101

Claims 1, 13, and 25 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that claims 1, 13, and 25 are interpreted as a computer product. Applicants agree that independent claim 13 is directed to a "program product" by its terms. In view of the Examiner's concerns, independent claim 13 has been amended to expressly recite that the "program product" is in fact "stored on a computer-readable medium," thus overcoming the stated ground of rejection.

Applicants respectfully disagree that claims 1 and 25 are properly interpreted as directed to an article of manufacture (i.e. computer program product stored on a signal bearing media). Claim 1 is directed to a method for instrumenting an HDL design entity including method steps described with reference to Figures 4A-4E, 8A-8C, and 9 that coincide with the construction of a program product (HDL file constructed in a particular manner). Similarly, claim 25 is directed to a method for instrumenting an HDL design entity including method steps described with reference to Figures 4A-4E, 8A-8C, and 9. The primary embodiments depicted in Figures 4A-4E, 8A-8C, and 9 demonstrate the inventive concept in the context of computer files (e.g. HDL source code files, instrumentation entity source code files, etc.), data processing and storage constructs (compiled instances, proto data structures), and processing entities. Applicants contend that the fact that one embodiment may be expressed as an article of manufacture does not preclude claimed embodiments expressed as methods or systems.

Independent claims 1 and 25 have been amended to more clearly characterize and define the nature of the method and system recited therein. For example, claim 1 now recites "[i]n a computer-aided design and verification system, a method for instrumenting a hardware description language (HDL) design entity ..." Claim 25 has been similarly amended.


Allowable Subject Matter

In paragraph 1 of the Office Action, the Examiner has indicated that claims 2-3, 6-12, 14-15, 18-24 and 26-36 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 101 set forth above and to include all of the limitations of the base claims and any intervening claims. In view of the indicated allowability of dependent claims 2, 14, and 26, independent claims 1, 13, and 25 have been amended to incorporate the limitations of claims 2, 14, and 26, respectively, which have been canceled accordingly. Applicants submit that claims 1, 13, 25 and all claims depending therefrom have been placed in condition for allowance and a Notice to that effect is hereby respectfully requested.

Applicants invite the Examiner to contact the undersigned attorney of record at (512) 343-6116 if such would further or expedite the prosecution of the present Application.

No extension of time is believed to be required. However, in the event that an extension of time is required, please charge that extension fee and any other required fees to IBM Corporation Deposit Account Number 09-0447.

Respectfully submitted,



Matthew W. Baca
Reg. No. 42,277
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
Telephone (512) 343-6116
Facsimile (512) 343-6446

ATTORNEY FOR APPLICANTS